

REMARKS

Claims 16, 19-20 and 23-24 are pending. Claims 16 and 19 have been amended herein.

Support for the amendment is detailed below. Claims 18 and 22 have been cancelled herein without prejudice.

Specification

Applicants have reviewed the application and do not note any substantial number of errors.

Applicants respectfully request the Examiner assistance in identifying any errors.

Applicants response to the Double Patenting Rejection

Claims 16, 18-20 and 22-24 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,447,909 in view of WO99-01766. In response thereto, and pursuant to 37 C.F.R. 1.130(b), applicants have submitted herewith a Terminal Disclaimer for U.S. Patent No. 6,447,909. Applicants respectfully request removal of the rejection.

Applicants' Response to Claim Rejections under 35 U.S.C. §112

Claims 16, 18-20, and 22-24 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action asserts that there is insufficient support for the added limitation of "over 50 wt%."

Applicants had possession of the invention when the current application was filed. Applicants refer to USP 6,447,909 which further details applicants' work. In column 6, line 45 to column 7, line 42 (among others, in column 7, lines 26-33), this patent provides a detailed description of the technical importance that the gold content in the noble metal microparticles should be set within a range "exceeding 50 wt% up to 95 wt%." Hence, applicants clearly had possession of the claimed invention at the time of filing of the application.

Applicants respectfully submit that sufficient support and recitation of the importance that the gold content exceeds 50% is also found in the specification on page 18, lines 7-16. According to MPEP §2163.05, citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), an analysis of a change in range claims must take into account which ranges one skilled in the art would consider inherently supported by discussion in the original disclosure. Additionally, amended claims 16 and 19 are based in part on Table 1a of the specification at pages 49-50. Herein, the "gold content" is set forth as always exceeding 50% by weight of the Ag-Au microparticle. In other words, the microparticle contains over 50 wt% of gold. Wherefore, applicants respectfully submit that the subject matter of the limitation is sufficiently described in the specification.

Applicants' Response to Claim Rejections under 35 U.S.C. §103

Claims 16, 19, 20, and 24 stand rejected under 35 U.S.C. §103 as being unpatentable over JP 11-203943 in view of WO99-01766. In response thereto, applicants have amended independent claims 16 and 19 to more distinctly claim the subject matter regarded as the invention. Specifically, applicants have removed the term "gold microparticles" and added the

limitations from dependant claims 18 and 22 directed to the microparticle of gold coated silver.

Applicants respectfully submit that the cited prior art does not disclose this limitation.

According to the invention described in JP 11-203943 (Yukinobu), the gold content in the noble metal-coated silver particles is set within a range of 5 to 100 parts by weight based on 100 parts by weight of silver (see claim 2 of JP 11-203943). When this range of gold contents is converted to a weight percentage, the upper limit is determined to be 50 wt%.

Thus, the gold content in the gold-coated silver microparticles specified by the claimed invention is different than the gold content in the noble metal-coated silver particles taught by JP 11-203943 (Yukinobu). In the present invention, the gold content in the gold-coated silver microparticles must range from "over 50 wt% to 95 wt%," and the resultant transparent conductive layer that uses such gold-coated silver microparticles exhibits improved weather resistance, ultraviolet ray resistance, chemical resistance, etc.

In addition, in the transparent conductive layer which is formed by using a coating liquid for forming a transparent conductive layer set forth in claim 16 or 19 as amended, and a coating liquid for forming a transparent coating layer composed mainly of a binder such as silica sol or the like and a solvent, and which includes "gold-coated silver microparticles" and "a binder matrix containing at least one functional group selected from mercapto groups (-SH), sulfide and groups (-S-), and polysulfide groups (-S_x, x ≥ 2)," the bond between the "gold-coated silver microparticles" and the "binder matrix" is strong by the action of the functional group. Thus, the film strength, weather resistance, etc., of the transparent conductive layer is remarkably improved. See page 14, line 9-22 and page 27, line 15 to page 29, line 14 of the specification.

Application No. 09/645,471
Group Art Unit: 1773

Amendment Under 37 C.F.R. § 1.111
Attorney Docket No. 000996

For the reasons indicated above, applicants respectfully submit that the invention set forth in amended claims 16 and 19, and dependent claims 20, 22 and 24 is clearly distinguishable from any invention that may be derived from a combination of JP 11-203943 (Yukinobu) with WO 99/01766 (Buining). Wherefore, applicants respectfully request favorable reconsideration.

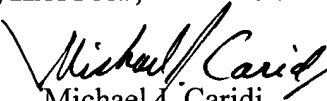
In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP


Michael J. Caridi
Attorney for Applicants
Registration No. 56,171
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

MJC/mlj